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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/218,277	12/22/98	EISENBACH-SCHWARTZ	M EISHENBACH=3
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EXAMINER

TURNER, S

ART UNIT

PAPER NUMBER

1647

13

DATE MAILED:

08/15/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trad marks**

# Office Action Summary

Application No.  
09/218,277

Applicant(s)

Eisenbach-Schwartz

Examiner  
Sharon L. Turner, Ph.D.

Group Art Unit  
1647



☒ Responsive to communication(s) filed on 7-12-00

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle* 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claim

☒ Claim(s) 1-15 is/are pending in the application.  
Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☐ Claim(s) \_\_\_\_\_ is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☒ Claims 1-15 are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☒ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

Art Unit: 1647

## DETAILED ACTION

### *Election/Restriction*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1 and 3-15 to the extent of claim 1, drawn to a method of preventing or inhibiting axonal degeneration, classified in class 424, subclass 93.1.
  - II. Claims 2 and 3-15 to the extent of claim 2, drawn to a method of promoting nerve regeneration, classified in class 424, subclass 184.1.
2. The inventions are distinct, each from the other because of the following reasons:
3. The inventions of Groups I-II are related as processes. The processes are distinct each from the other because they produce different effects, comprise different steps and utilize different reagents. Groups I and II are distinguished either by preventing or inhibiting axonal degeneration or by promoting nerve regeneration.
4. This application contains claims directed to an indeterminate number of inventions comprising the following patentably distinct species of the claimed invention: Methods of treatment of Species 1; a) Method delivering T-cells, b) Method delivering antigen, c) Method delivering derived peptide, d) Method delivering a nucleotide encoding a NS antigen, d) Method delivering a nucleotide encoding a derived NS antigen and e) a specific combination of a)-e) in which all components of the treatment must be defined. In addition the claims are directed to the following patentably distinct species of NS-antigens and sequences of Species 2; a) myelin basic protein, b) myelin oligodendrocyte glycoprotein, c) proteolipid protein, d) myelin-associated

Art Unit: 1647

glycoprotein, e) S100, f)  $\beta$ -amyloid, g) Thy-1, h) P0 and I) P2. Further, the claims are directed to the following patentably distinct injuries of Species 3; a) blunt trauma, b) penetrating trauma, c) hemorrhagic stroke, d) ischemic stroke, and e) damage caused by surgery. Still further, the claims are directed to the following patentably distinct diseases of Species 4; a) diabetic neuropathy, b) senile dementia, c) Alzheimer's disease, d) Parkinson's disease, e) facial nerve palsy, f) glaucoma, g) Huntington's chorea, h) amyotrophic lateral sclerosis, I) non-arteritic optic neuropathy and j) vitamin deficiency.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for each of the delineated 4 species sets as set forth above for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1 and 2 are generic. Should applicant elect species 1(e) as set forth above applicant is required to specify the specific combination including all elements of the treatment.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected for each of species groups 1-4 consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after

Art Unit: 1647

the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Because these inventions are distinct for the reasons given above and the search required for any of the Groups is not required for any other Group, restriction for examination purposes as indicated is proper.

5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their different classification and recognized divergent subject matter, restriction for examination purposes as indicated is proper.

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).


7. Any inquiry of a general nature or relating to the status of this general application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Art Unit: 1647

Papers relating to this application may be submitted to Technology Center 1600, Group 1640 by facsimile transmission. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). Should applicant wish to FAX a response, the current FAX number for Group 1600 is (703) 308-4242.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sharon L. Turner, Ph.D. whose telephone number is (703) 308-0056. The examiner can normally be reached on Monday-Friday from 8:00 AM to 4:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Kunz, can be reached at (703) 308-4623.

Sharon L. Turner, Ph.D.  
August 9, 2000

  
**GARY L. KUNZ**  
**SUPERVISORY PATENT EXAMINER**  
**TECHNOLOGY CENTER 1600**